

REMARKS

Claims 1-15 and 22-27 are pending in this application. In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claim 22 has been rewritten to include the features previously recited in canceled claim 26. In addition, independent claim 11 has been rewritten to further clarify that the cover layer does not include ionomeric materials. As no new matter has been added by the amendments herein, Applicant respectfully requests entry of these amendments at this time.

ALLOWABLE SUBJECT MATTER

Applicant appreciates the Examiner's recognition of allowable subject matter in claims 1 and 3-10. In addition, Applicant appreciates the Examiner's recognition of allowable subject matter in dependent claim 26 if rewritten in independent form. In response, Applicant has rewritten independent claim 22 to include the features previously recited in now-cancelled claim 26. As such, Applicant respectfully submits that independent claim 22, and those depending therefrom, are in condition for allowance.

THE REJECTIONS UNDER 35 U.S.C. §§ 102 and 103

Claims 11-15, 22-25, and 27 were rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,730,663 to Tanaka *et al.* for the reasons set forth on page 2 of the Office Action. In addition, claims 11-15, 22-25, and 27 were rejected under § 102(a) as anticipated by or, in the alternative, as obvious over Japanese Patent No. 8322962 (a Japanese equivalent of the Tanaka '663 patent) for the reasons stated on page 4 of the Office Action.

Because independent claim 22 has been rewritten to include subject matter indicated by the Examiner to be allowable, Applicant respectfully submits that the rejection of claims 22-25 and 27 is overcome. In addition, Applicant respectfully submits that neither reference discloses or even suggests the invention presently recited in independent claim 11, and those depending therefrom, for the reasons that follow.

Tanaka and Japanese Patent No. 8322962

Tanaka '665 generally discloses a solid golf ball with an inner and outer cover layer made of a composition consisting mainly of ionomer resin. *See* Abstract. The Examiner relies on Comparison Examples 2 and 4 (*See* Col. 7, Table 4) to show disclosure of an inner cover layer including a polyamide homopolymer (*i.e.*, Nylon 12) and an ionomeric material within the ranges presently recited in independent claim 11. With regard to the § 102 rejection based on Tanaka '665, however, Tanaka '665 does not disclose or even suggest a cover layer formed from a non-ionomeric thermoplastic polymer material, as presently recited. In contrast, Tanaka '665 teaches and provides examples and comparison examples including ionomer resins as the main component in both the inner and outer cover layers. While Tanaka '665 does discuss inclusion of non-ionomeric materials, the compositions always include ionomer resins as the main component. *See* Col. 4, lines 13-15. As such, Tanaka '665 does not anticipate the present invention.

Furthermore, while a patent may be relied upon as prior art for all it contains, including nonpreferred embodiments and disclosed examples, the reference may only be used “for all that it would have reasonably suggested to one having ordinary skill in the art.” MPEP § 2123 (2100-61). By nature, a comparison example signifies to one of ordinary skill in the art that it is not the preferred embodiment. Most times, the comparison example includes materials, amounts, or other parameters that the reference teaches away from using. For example, as discussed in the last Response, the comparison examples use an amount of polyamide homopolymer in the ionomeric composition that is outside of the amount preferred by Tanaka '665. In fact, Tanaka '665 teaches to use “not more than 10% by weight” polyolefins or polyamides in the ionomer composition (*see* Col. 4, lines 34-38), whereas the comparison examples use 40 parts by weight Nylon 12.

As such, a skilled artisan would have either used the comparison examples for what they disclosed, or the teachings of Tanaka '665, but not a combination of both. To suggest that such a combination would have been obvious would require the use of impermissible hindsight. And, even if the reference would have “reasonably suggested to one having ordinary skill in the art” to use the inner cover layer of the comparison example with a larger amount of polyamide homopolymers than preferred with the remainder of the ball following the Tanaka '665 teaching, *arguendo*, the combination would not have resulted in the present invention because the outer cover layer would have included ionomers.

In sum, because the comparison example cited by the Examiner includes an inner cover layer and an outer cover layer, as well as a core, a skilled artisan would have used the

complete disclosure of the comparison example, not select parts, to create a finished golf ball. In doing so, the finished golf ball would include a cover layer including ionomeric material, of which independent claim 11 expressly avoids as a cover material. For example, Comparison Example 4 includes an inner cover layer as described by the Examiner on page 2 of the Office Action and an outer cover including high acid content ionomers Iotek 8000 and Hi-Milan 7315. Col. 7, Table 4. Thus, the comparison examples included in Tanaka '665 do not render obvious the invention presently recited in independent claim 11.

As the Examiner stated in the Office Action, JP 8322962 is an equivalent of Tanaka. See Office Action at Page 4. In light of this equivalence, like Tanaka, JP 8322962 does not disclose or suggest the invention recited in independent claim 11, and those depending therefrom.

For the reasons above, Applicant respectfully submits that claims 11-15 is not anticipated or rendered obvious by Tanaka or JP 8322962. As such, Applicant respectfully requests reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicant invites the Examiner to contact the undersigned attorneys to discuss any remaining issues.

No fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 195127, Order No. 20002.0220.

Respectfully submitted,

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